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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,643	04/30/2001	Srikar Rao	Rao - utility	3965

7590 02/27/2002

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/845,643

Applicant(s)
Rao

Examiner
Steven Wong

Art Unit
3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 30, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-12 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

20) ☐ Other:

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-8, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al. in view of Giglio. Regarding claims 1, 6 and 11, Hoyt et al. disclose a golf ball marker and holder system comprising a clip (10) sized for attachment to a shoe (14) and a ball marker (30) having a solid face removably attached to the clip. However, Hoyt et al. disclose a marker which is attached to the clip by a pin (28) which is received by a orifice (26) instead of a magnetic arrangement as instantly claimed.

Giglio reveals a ball marker and holder system comprising a clip (20) and a ball marker (24) which is attached to the clip by a magnet (16). The marker is made from a ferrous material. It would have been obvious to one of ordinary skill in the art to replace the ball marker with the post and orifice arrangement of Hoyt et al. with the magnetic arrangement taught by Giglio in order to provide an alternative arrangement for removably attaching the ball marker to the clip of Hoyt et al.

Regarding claims 2, 8 and 12, the ball marker of Giglio provides a recessed cavity (14) positioned to receive the ball marker.

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Regarding claims 3 and 7, the ball marker arrangement of Giglio provides the clip with a magnetic portion and the ball marker with a ferrous portion.

3. Claims 4, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al. in view of Giglio and Kennedy. Regarding claims 4 and 9, Giglio provides a means (32) for removing the ball marker from cavity.

Kennedy reveals a golf mark retaining device including a recess (16) and an indentation (60) for assisting in grasping the ball marker. It would have been obvious to one of ordinary skill in the art to replace the means (32) of Giglio for removing the ball marker from the cavity with the indentation of Kennedy in order to assist the user in removing the ball marker from the cavity.

Regarding claims 9 and 10, Giglio states that it is well known in the art to provide indicia on the top surface of ball markers such as the name of a golf equipment manufacturer (column 2, lines 8-11).

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is (703) 308-3135.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

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Official responses, subject to the provisions of 37 C.F.R. 1.6(d), can be faxed to (703) 305-3579.

Unofficial faxes which are meant for discussion purposes only should be sent to (703) 308-7768. It is strongly suggested that the examiner be contacted directly before sending any unofficial fax.


Steven Wong
Primary Examiner
Art Unit 3711

SBW
February 22, 2002